

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TODD CHARLES MCNEEL, NELSON SHIH-HSUN CHEN,
and LAWRENCE ALAN GRAHAM

Appeal 2007-0364
Application 09/998,661
Technology Center 1700

Decided: March 6, 2007

Before BRADLEY R. GARRIS, THOMAS A. WALTZ, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Primary Examiner's final rejection of claims 1 through 3, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134.

According to Appellants, the invention is directed to a method of making triangular tortilla chips in a manner which facilitates subsequent

packaging of the chips in a stacked arrangement (Br. 2).¹ Independent claim 1 is illustrative of the invention and is reproduced below:

1. A method of making triangular tortilla chips in a manner which facilitates subsequent packaging in a stacked arrangement, said method comprising:

cutting triangular tortilla chip preforms from a sheet of masa;

enclosing the tortilla chip preforms in molds with a consistent orientation;

restraining the tortilla chip preforms within said molds while cooking the tortilla chip preforms in a cooking medium, thereby substantially maintaining the orientation of the tortilla chip preforms while they are being cooked; and then

removing cooked tortilla chips from said molds while substantially maintaining the orientation of the tortilla chip preforms;

wherein said consistent orientation comprises an alternating pattern of tortilla chip preforms with base edges and apex corners of successive tortilla chip preforms within the molds alternating orientation, whereby said tortilla chip preforms can be placed relatively compactly and close together within said molds so as to minimize space therebetween.

The Examiner has relied upon the following references as evidence of obviousness:

MacKendrick	US 3,520,248	Jul. 14, 1970
Hilton	US 4,052,838	Oct. 11, 1977
Wisdom	US 4,122,198	Oct. 24, 1978
Khalsa	US 5,298,274	Mar. 29, 1994

¹ We refer to and cite from "Appellants' Substitute Brief on Appeal under 37 C.F.R. § 41.37" dated June 9, 2005.

ISSUES ON APPEAL

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Wisdom in view of Hilton, Khalsa, and MacKendrick (Answer 3).²

Appellants contend that the applied references do not teach or suggest all of the claim limitations, specifically the step of restraining triangular tortilla chip preforms while arranged in alternating orientations within molds while cooking or removing the preforms (Br. 3-4).

Appellants also contend that there is no motivation or suggestion for combining the teachings of the applied references (Br. 3-4 and 6-7).

The Examiner contends that the applied prior art, as a whole, suggests every claim limitation and teaches the benefits of restraining the preforms while cooking (Answer 4-6).

Accordingly, the issues in this appeal are as follows: (1) do the applied references teach or suggest every claim limitation?; and (2) is there sufficient motivation or suggestion for combining the references as proposed by the Examiner?

We determine that the Examiner has established a prima facie case of obviousness in view of the reference evidence, showing that every claim limitation was known in the prior art, as well as showing a reason, suggestion or motivation for combining these various process limitations.

² We refer to and cite from the “new Examiner’s Answer” dated Jun. 28, 2005. We note that the Examiner has inadvertently omitted the statement of the rejection on page 3 of this Answer (¶ (9)). We hold this omission harmless since the correct rejection on appeal has been recognized by Appellants (Br. 3, ¶ VI) and has been previously stated by the Examiner (Final Office Action dated Jun. 2, 2004, and the Answer dated Dec. 2, 2004, page 3).

We determine that Appellants have not adequately rebutted this prima facie case of obviousness by their arguments. Therefore we AFFIRM the sole ground of rejection in this appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

OPINION

We determine the following factual findings from the record in this appeal:

- (1) Wisdom discloses cutting chip preforms from a sheet of masa, enclosing the chip preforms in molds, and restraining the chips in the molds during toasting and subsequent frying (col. 4, ll. 12-34; Answer 4);
- (2) Wisdom teaches that the preferred chip products conform to the shape of the mold so that the chips “may be of uniform size and shape and capable of being stacked” (col. 2, ll. 52-55; Answer 4);
- (3) Hilton discloses that corn chips have generally been fried into non-uniform shapes, and thus necessitating that these chips be packaged in large inexpensive containers and subject to deterioration within a short time (col. 1, ll. 10-21);
- (4) Hilton teaches cutting uniformly shaped (any “desired shape”) chips from dough, and frying these chips while restrained in a mold to permit packaging the nested, uniformly shaped product in relatively smaller containers with less amount of breakage (col. 1, ll. 22-50; Answer 4);

- (5) MacKendrick discloses the same problem as Hilton, namely the random shape of chips require them to be randomly packaged in a low bulk density packaging with a large amount of air space (col. 1, ll. 40-46);
- (6) MacKendrick teaches a method of preparing uniformly shaped chip products by cutting dough sections of any “predetermined size and shape” from a sheet of dough, enclosing the chip preforms in a mold, and restraining the chip preforms in the mold during frying (col. 3, ll. 1-36; Figure 7; and Answer 5);
- (7) MacKendrick teaches that the mold members are configured to impart the desired shape to the fried chips and to restrain the dough sections during the frying operation (col. 6, ll. 13-69; Answer 5);
- (8) Khalsa teaches cutting “desired dough shapes” from a sheet of masa dough before the cut shapes are baked, fried, and packaged (col. 2, ll. 6-7; col. 3, ll. 4-11; col. 4, ll. 63-64);
- (9) Khalsa teaches that one “desired shape” of dough preform is triangular, illustrating a cutting means that provides triangular dough shapes in alternating orientation (col. 5, ll. 42-47; *see* cutting edges 76 in Figure 2).

When determining the patentability of a claimed invention which combines several known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *See In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ

481, 488 (Fed. Cir. 1984). Evidence of a suggestion, teaching, or motivation to combine the prior art teachings may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996).

Applying the preceding legal principles to the factual findings on the record in this appeal, we determine that the Examiner has established a *prima facie* case of obviousness in view of the reference evidence. As established by the factual findings listed above, the applied prior art shows that triangular shapes were known for chip preforms, as was enclosing and restraining chip preforms in molds during the frying operation. Similarly, alternating orientation for triangular chips was disclosed by Khalsa, and the benefits of removing these uniformly shaped chips in an orientation so that they could be stacked and packaged in a small, air-tight container was also taught by the applied prior art.

The suggestion or motivation for combining the applied references as proposed by the Examiner's rejection may be found in the references themselves and the nature of the problem to be solved (Answer 4-6). Wisdom teaches that the preferred chip products conform to the shape of the mold so that the chips "may be of uniform size and shape and [are] capable of being stacked" (*see* factual finding (2) above). Both Hilton and MacKendrick disclose the nature of the problem to be solved, i.e., random chip formation necessitates packaging in large inexpensive containers with a large amount of air space and breakage (*see* factual findings (3) and (5) above). Hilton and MacKendrick both teach the same solution to this

problem, namely a method of preparing uniformly shaped chips with “any desired shape” so that the chips can be packaged in relatively small, air-tight containers with less breakage (*see* factual findings (4) and (6) above).

Khalsa teaches that one desired shape known in this art is a triangular shape chip, cut with alternating orientation (*see* factual finding (9) above).

Wisdom, Hilton, and MacKendrick all disclose or suggest restraining the chip preforms in molds while frying (*see* factual findings (1), (4), and (6) above). Accordingly, we agree with the Examiner that it would have been obvious to one of ordinary skill in this art to form chips with the triangular shape as taught by Khalsa, with the accompanying alternating orientation, in restraining molds during the frying operation to form uniformly shaped chips capable of being stacked and packaged in smaller, air-tight containers, as taught by Hilton and MacKendrick, in the process of Wisdom (Answer 4-6).

For the foregoing reasons and those stated in the Answer, we determine that the Examiner has established a *prima facie* case of obviousness in view of the reference evidence. We also determine that Appellants’ arguments have not adequately rebutted this *prima facie* case. Therefore we affirm the rejection of claims 1-3 under 35 U.S.C. § 103(a) over Wisdom in view of Hilton, Khalsa, and MacKendrick.

The decision of the Examiner is affirmed.

Appeal 2007-0364
Application 09/998,661

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

sld/ljs

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005